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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,439	10/24/2003	James D. Marshall	P-TN-09409	2022

7590 02/25/2005

Black & Decker Inc.
TW-199
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EXAMINER	
AL NAZER, LEITH A	

ART UNIT	PAPER NUMBER
2821	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No.	Applicant(s)	
	10/693,439	MARSHALL ET AL.	
	Examiner	Art Unit	
	Leith A. Al-Nazer	2821	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 January 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,5-10 and 12-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,5-10 and 12-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 January 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 5-10, and 12-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5, 6, 11, and 12 of U.S. Patent No. 10/277,474 in view of U.S. Patent No. 6,459,483 to Shafer et al and U.S. Patent No. 4,910,717 to Terry.

Claim 1 of the present application and claim 1 of Application No. 10/277,474 contain the same limitations except that claim 1 of the present application requires an electronic distance measuring circuit be disposed in the housing of the laser level for measuring the distance to a targeted object. Distance measuring circuits/apparatus are well known in the art, as is evidenced by Shafer (figure 11). At the time of the invention, it would have been obvious to one having ordinary skill in the art to take the laser level

of Application No. 10/277,474 and include a distance measuring circuit in the laser level. The motivation for doing so would have been to provide means for determining the distance to a target point while simultaneously utilizing other functions of the laser level.

Claims 5 and 12 of the present application and claim 2 of Application No. 10/277,474 contain the same limitations.

Claim 6 requires the distance measuring circuit comprise a laser transmitter. Shafer teaches such a setup (1100 in figure 11).

Claim 7 requires the distance measuring circuit comprise a laser receiver. Shafer teaches such a setup (1140 in figure 11).

Claims 8 and 9 require the distance measuring circuit comprise a sound transmitter and a sound receiver, respectively. It is well known in the art that one can use a sound transmitter and receiver rather than a laser transmitter and receiver, as is evidenced by Terry (column 1, line 48 – column 2, line 5). Therefore, it would have been obvious to one having ordinary skill in the art to utilize a sound transmitter and receiver, as taught by Terry, rather than a laser transmitter and receiver. The motivation for doing so would have been to provide further means for measuring distances to target objects. A sound transmitter and receiver also would provide a benefit over a laser transmitter and receiver because a direct line-of-sight view of the target object would not necessarily be required when using a sound transmitter and receiver.

Claim 10 requires the distance measuring circuit comprise a display disposed on the housing. Such a setup is well known in the art, as is evidenced by Shafer (column 8, lines 38-41).

Claim 13 of the present application and claim 3 of Application No. 10/277,474 contain the same limitations.

Claim 14 of the present application and claim 5 of Application No. 10/277,474 contain the same limitations.

Claim 15 of the present application and claim 6 of Application No. 10/277,474 contain the same limitations.

Claim 16 of the present application and claim 11 of Application No. 10/277,474 contain the same limitations.

Claims 17 of the present application and claim 12 of Application No. 10/277,474 contain the same limitations.

Claim 18 requires at least one bubble vial be disposed on the housing. Such a configuration is common in the art and is suggested in claim 47 of Application No. 10/277,474. Therefore, at the time of the invention, it would have been obvious to one having ordinary skill in the art to utilize a bubble vial on the laser level of the present application. The motivation for doing so would have been to provide means for determining the tilt of the laser level relative to a ground plane.

3. Claim 12 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 5. When two claims in an application are duplicates or else are so close in

content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 5-10, and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0231303 to Raskin et al in view of U.S. Patent No. 6,459,483 to Shafer et al.

With respect to claim 1, Raskin teaches a laser level disposable on a substantially vertical reference surface comprising a housing (figure 1); a pendulum (30) pivotably connected to the housing; a first laser diode (42) disposed on the pendulum

for emitting a first laser beam along a first path; a first lens (43) disposed on the pendulum in the first path for converting the first laser beam into a first planar beam, the first beam forming a first line on the reference surface. Claim 1 requires an electronic distance measuring circuit be disposed in the housing for measuring distance. Such circuits are well known in the art, as is evidenced by Shafer (figure 11). At the time of the invention, it would have been obvious to one having ordinary skill in the art to take the laser level of Raskin and the include a distance measuring circuit in the laser level. The motivation for doing so would have been to provide means for determining the distance to a target point while simultaneously utilizing other functions of the laser level.

With respect to claims 5 and 12, Raskin teaches a second laser diode disposed on the pendulum for emitting a second laser beam along a second path, and a second lens disposed on the pendulum in the second path for converting the second laser beam into a planar beam, the planar beam forming a second line on the reference surface (paragraph 0089).

With respect to claim 6, Shafer teaches the distance measuring circuit comprising a laser transmitter (1100 in figure 11).

With respect to claim 7, Shafer teaches the distance measuring circuit comprising a laser receiver (1140 in figure 11).

With respect to claim 10, Shafer teaches a distance measuring circuit comprising a display disposed on the housing (column 8, lines 38-41).

With respect to claim 13, Raskin teaches the first and second lines being substantially perpendicular (paragraph 0089).

With respect to claim 14, Raskin teaches a detector circuit disposed in the housing for detecting a feature behind of underneath the reference surface (30 in figure 11).

With respect to claim 15, Raskin teaches the detector circuit detecting at least one of the group consisting of studs, wires, and pipes (paragraph 0034).

With respect to claim 16, Raskin teaches the housing at least partially enclosing the pendulum (figure 2).

With respect to claim 17, Raskin teaches the housing having at least one window (13 in figure 1) for allowing the first planar beam to exit therethrough.

With respect to claim 18, Raskin teaches at least one bubble vial on the housing (paragraph 0089).

7. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0231303 to Raskin et al in view of U.S. Patent No. 6,459,483 to Shafer et al as applied to claims 1, 5-10, and 12-18 above, and further in view of U.S. Patent No. 4,910,717 to Terry.

Claims 8 and 9 require the distance measuring circuit comprise a sound transmitter and a sound receiver, respectively. It is well known in the art that one can use a sound transmitter and receiver rather than a laser transmitter and receiver, as is evidenced by Terry (column 1, line 48 – column 2, line 5). Therefore, it would have been obvious to one having ordinary skill in the art to utilize a sound transmitter and receiver, as taught by Terry, rather than a laser transmitter and receiver. The

motivation for doing so would have been to provide further means for measuring distances to target objects. A sound transmitter and receiver also would provide a benefit over a laser transmitter and receiver because a direct line-of-sight view of the target would not necessarily be required when using a sound transmitter and receiver.

Response to Arguments

8. Applicant's arguments with respect to claims 1, 5-10, and 12-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Communication Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leith A. Al-Nazer whose telephone number is 571-272-1938. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LA

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